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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,180	06/22/2001	Thomas Brinz	10191/1925	7242

26646 7590 02/13/2004

KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

SNAY, JEFFREY R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

09/887.180

**Applicant(s)**

BRINZ ET AL.

Examiner

Jeffrey R. Snay

## Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-9 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Singh (WO 94/10533).

The reasons for this rejection are as set forth in paragraph 3 of the last office action. With respect to new claim 14, it is noted that the particles of Singh were disclosed as composed of glass, silica, or PMMA (page 3 of Singh), all of which would inherently have been water insoluble.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Singh, for the reasons stated in paragraph 7 of the last Office action.
6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of Markle et al, for the reasons stated in paragraph 8 of the last Office action.

### ***Response to Arguments***

7. Applicant's arguments filed 11-10-03 have been fully considered but they are not persuasive.

Applicant traverses the rejection of claim 1 as anticipated by Singh on the grounds that Singh teaches a sensitive layer deposited on particles, rather than the presently recited sensitive layer containing particles. This interpretation misreads the Singh disclosure. Singh discloses a sensitive layer which is depicted as element (22) in Figure 2, which sensitive layer is positioned on a support (12). The sensitive layer (22) in Singh includes glass or polymer particles on which an indicator dye is immobilized. Thus, the limitation of claim 1 requiring a sensitive layer containing particles is fully met by Singh.

Applicant further traverses the rejection of claim 2 on the grounds that Singh teaches use of the sensor device in blood, rather than in air. The argument is irrelevant

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because it asserts only an intended use of the device. Such intended use is of no consequence to a claimed device which is fully anticipated by the prior art.

Applicant further traverses the rejection of claim 3 on the grounds that Singh teaches PMMA as a substrate rather than particles. The argument is not persuasive because Singh, at page 3, in fact teach the alternative use of PMMA in forming the solid surface support particles onto which the indicator dye is immobilized (emphasis added). Singh in fact teaches the use of polymers such as PMMA as an alternative to the glass or silica based particle materials described in the same paragraph on page 3.

Applicant further traverses the rejection of claim 5 on the grounds that Singh's characterization of the particles as porous would not meet the presently claimed limitation of "hollow". This argument is not persuasive. Words of a claim are given their ordinary meaning, absent a clear expression in the specification that applicant has intended some alternative special meaning to be imposed. Merriam-Webster's Collegiate Dictionary, 10th edition, defines the word hollow as; "an unfilled space: CAVITY, HOLE", and "having a cavity within". Thus, nothing in the ordinary meaning of the term hollow would require the narrow definition now suggested by applicant - "having a single surface and an extended interior that is filled with an at least different type of material or gas". The particles of Singh are porous and thus filled with internal voids. Such voids would either independently or collectively have constituted a "cavity within" and therefore rendered the particles as hollow.

Applicant further traverses the rejection of claim 12 apparently on the grounds that the incorporated patent within Singh discloses a substrate which is connected to a

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detector rather than the presently recited limitation that the "substrate includes a detector". However, the term "includes" in applicant's claim requires no more than a functional association, or at most a physical association. The detector either implicitly disclosed by Singh or explicitly incorporated by Singh was clearly connected, both optically and physically with the fiber optic substrate. Anticipation of the instant claims requires no more.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey R. Snay  
Primary Examiner  
Art Unit 1743

jrs